REMARKS:

Claims 1-45 are currently pending in the application. Claims 2, 4-7, 12, 18-20, 25, 32-35, and 40 stand objected to as being dependent upon a rejected base claim. Claims 1, 3, 8-11, 13-17, 21-24, 26-31, 36-39, and 41-45 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,787,000 to Lilly et al. ("Lilly") in view of U.S. Patent No. 5,548,518 to Dietrich et al. ("Dietrich").

Claims 1, 3, and 31 have been cancelled without prejudice. Although the Applicants believe claims 1-45 are directed to patentable subject matter and are in condition for allowance without amendment. The Applicants have amended claims 2, 4, 5, 8-15, 17, 18, 21-28, 30, 32, 33, 36-43, and 45 to more particularly point out and distinctly claim the Applicant's invention. No new matter has been added.

CLAIM OBJECTIONS:

The Examiner objects to claims 2, 4-7, 12, 18-20, 25, 32-35, and 40 as being dependent upon a rejected base claim, but indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In response to the Examiner's statement, the Applicants have amended claims 2, 4, and 32 as suggested by the examiner. The Applicants submit that claim 2 is now in independent form and includes all of the limitations of now cancelled independent base claim 1. The Applicants also submit that claim 4 is now in independent form and includes all of the limitations of now cancelled independent base claim 3. The Applicants further submit that claim 32 is now in independent form and includes all of the limitations of now cancelled independent base claim 31. Thus, the Applicants respectfully request that the objection to now independent claims 2, 4, and 32 be reconsidered and that now independent claims 2, 4, and 32 be allowed.

The Applicants respectfully submit that the Examiner acknowledges that the invention set forth in now independent claims 2, 4, and 32 are directed to a method, system and software of scheduling development planning wherein available resources are assigned an ability level and each task requiring a resource specifies an minimum ability level of one or more resources to be used for that task and the development schedule allocates to all tasks resources that have an ability level at least as high as the specified minimum ability level. The Applicants further submit that the Examiner acknowledges that now independent claims 2, 4, and 32 are not taught in the prior art of U.S. Patent No. 5,787,000 to Lilly et al. ("Lilly") or of U.S. Patent No. 5,548,518 to Dietrich et al. ("Dietrich"), either individually or in combination. Specifically the Examiner acknowledges that Lilly or Dietrich, either individually or in combination fails to teach the required resources having an ability level and each task specifying a minimum ability level of one or more resources to be used for that task and the development schedule allocates to all tasks resources that have an ability level at least as high as the specified minimum ability level.

With respect to dependent claims 5-30 and 33-45, claims 5-17 depend from now independent claim 2, claims 18-30 depend from now independent claim 4, and claims 33-45 depend from now independent claim 32. As mentioned above, each of now independent claims 2, 4, and 32 are considered patentably distinguishable over the proposed combination of Lilly and Dietrich. Thus, dependent claims 5-30 and 33-45 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For the reasons set forth herein, the Applicants submit that claims 2, 4-30 and 32-45 are not rendered obvious by the proposed combination of Lilly and Dietrich. The Applicants further submit that claims 2, 4-30 and 32-45 are in condition for allowance. Thus, the Applicants respectfully request that claims 2, 4-30 and 32-45 be allowed.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1, 3, 8-11, 13-17, 21-24, 26-31, 36-39, and 41-45 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,787,000 to Lilly et al. ("Lilly") in view of U.S. Patent No. 5,548,518 to Dietrich et al. ("Dietrich").

In an effort to expedite prosecution of this Application, the Applicants have cancelled independent claims 1, 3, and 31 and amended dependent claims 2, 4, and 32 so that claims 2, 4, and 32 are now in independent form and include the limitations of respective base claims 1, 3, and 31. In so amending Claims 2, 4, and 32, the Applicants have rendered moot the Examiners rejection of Claims 1, 3, 8-11, 13-17, 21-24, 26-31, 36-39, and 41-45 under 35 U.S.C. § 103(b). In so doing, the Applicants make no admission concerning the merits of the Examiner's now-moot rejection and denies affirmatively any statement of averment of the Examiner that is not specifically addressed in this Amendment.

For example, with respect to now independent claim 2, this claim recites:

> A method for scheduling development planning for a plurality of products of an enterprise, comprising:
>
> receiving a list of a plurality of products to be developed;
>
> receiving a list of required completion dates, each completion date specifying the completion date for the development of a corresponding product in the plurality of products;
>
> receiving, for each product in the plurality of products, a project definition of a project for developing the product, each project definition defining:
>
> a plurality of tasks required to complete a project for developing the product associated with the project definition; and
>
> a list of resources required to complete each task defined in the product definition, at least one of the plurality of tasks for at least one of the plurality of projects requiring a material to be provided by an outside party distinct from the enterprise;
>
> <u>receiving a list of available resources, each resource in the list of available resources is assigned an ability level and having a capacity as a function of time;</u>
>
> <u>receiving, for each task requiring a resource, a specified minimum ability level of one or more resources to be used for that task;</u>

receiving a list of materials available from outside parties distinct from the enterprise and a schedule of availability of the materials available from the outside parties; and

automatically generating a development schedule comprising all tasks for all projects, the development schedule allocating the resources such that each resource is allocated at a level less than or equal to its capacity, the development schedule also allocating the resources that have an ability level at least as high as the specified minimum ability level, the development schedule also scheduling tasks that require materials from outside parties at a time when such materials will be available. (Emphasis Added).

Now independent claims 4 and 32 recite similar limitations. Lilly and Dietrich either individually or in combination, fail to disclose each and every limitation of now independent claims 2, 4, and 32.

The Applicants respectfully submit that now independent claims 2, 4, and 32 are considered patentably distinguishable over the proposed combination of Lilly and Dietrich. Lilly and Dietrich do not disclose, suggest or even hint at the unique and novel limitations disclosed in now independent claims 2, 4, and 32. This being the case, now independent claims 2, 4, and 32 are considered patentably distinguishable over the proposed combination of Lilly and Dietrich.

With respect to dependent claims 5-30 and 33-45, claims 5-17 depend from now independent claim 2, claims 18-30 depend from now independent claim 4, and claims 33-45 depend from now independent claim 32. As mentioned above, each of now independent claims 2, 4, and 32 are considered patentably distinguishable over the proposed combination of Lilly and Dietrich. Thus, dependent claims 5-30 and 33-45 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For the reasons set forth herein, the Applicants submit that claims 2, 4-30 and 32-45 are not rendered obvious by the proposed combination of Lilly and Dietrich. The Applicants further submit that claims 2, 4-30 and 32-45 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 1, 3, 8-11, 13-17, 21-

24, 26-31, 36-39, and 41-45 under 35 U.S.C. § 103(a) be reconsidered and that claims 2, 4-30 and 32-45 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's

disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991; *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

6/7/05
Date

James E. Walton, Registration No. 47,245
Brian E. Harris, Registration No. 48,383
Steven J. Laureanti, Registration No. 50,274
Daren C. Davis, Registration No. 38,425
Michael Alford, Registration No. 48,707
Law Offices of James E. Walton, P.L.L.C.
1169 N. Burleson Blvd., Suite 107-328
Burleson, Texas 76028
(817) 447-9955 (voice)
(817) 447-9954 (facsimile)
jim@waltonpllc.com (e-mail)

CUSTOMER NO. 53184
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